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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,753

05/20/2008

Enrique Kogan-Frenk

3446-101

9668

6449

7590

09/01/2010

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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WASHINGTON, DC 20005

EXAMINER

BALLINGER, MICHAEL ROBERT

ART UNIT

PAPER NUMBER

3732

NOTIFICATION DATE

DELIVERY MODE

09/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No. 10/589,753	Applicant(s) KOGAN-FRENK, ENRIQUE	
	Examiner Michael R. Ballinger	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/20/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the post including, "a head adjacent to the body formed by a plurality of cylindrical segments" as recited in claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Additionally, the drawings are objected to under 35 CFR 1.84(m) because the drawing include solid black shading. 35 CFR 1.84(m) clearly states "solid black shading areas are not permitted, except when used to represent bar graphs or color." No new matter should be entered.
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.
5. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
6. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.
7. The abstract of the disclosure is objected to because it includes the legal phraseology "comprised" on lines 2 and 9 and it is not in narrative form. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
9. Claims 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. Claim 18 recites the limitation "a head adjacent to the body, formed by a plurality of cylindrical segments." There is no support for this limitation in the original specification. To the contrary the specification at page 6, lines 10-25 discusses a head having conical segments with at least one flat face so that "rotation of the nucleus will be prevented". The Examiner submits a cylindrical segment would not prevent rotation. As such, claims 18-20 are rejected for failing to comply with the written description requirement.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claims 19 and 20 recite the limitations "whereupon the post height adjustment consists in cutting one, two or three conical segments from the head" and "whereupon the height adjustment consists in cutting one or two cylindrical segments of the apical portion", respectively. The usage of "consists" in combination with "or" in each instance is improper (see MPEP 2173.05(h)). The Examiner suggests amending the claims to substitute the term "comprises" for "consists in", to overcome this rejection. Additionally, the terms "the post height adjustment" and "height adjustment" lack antecedent basis in the claims.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

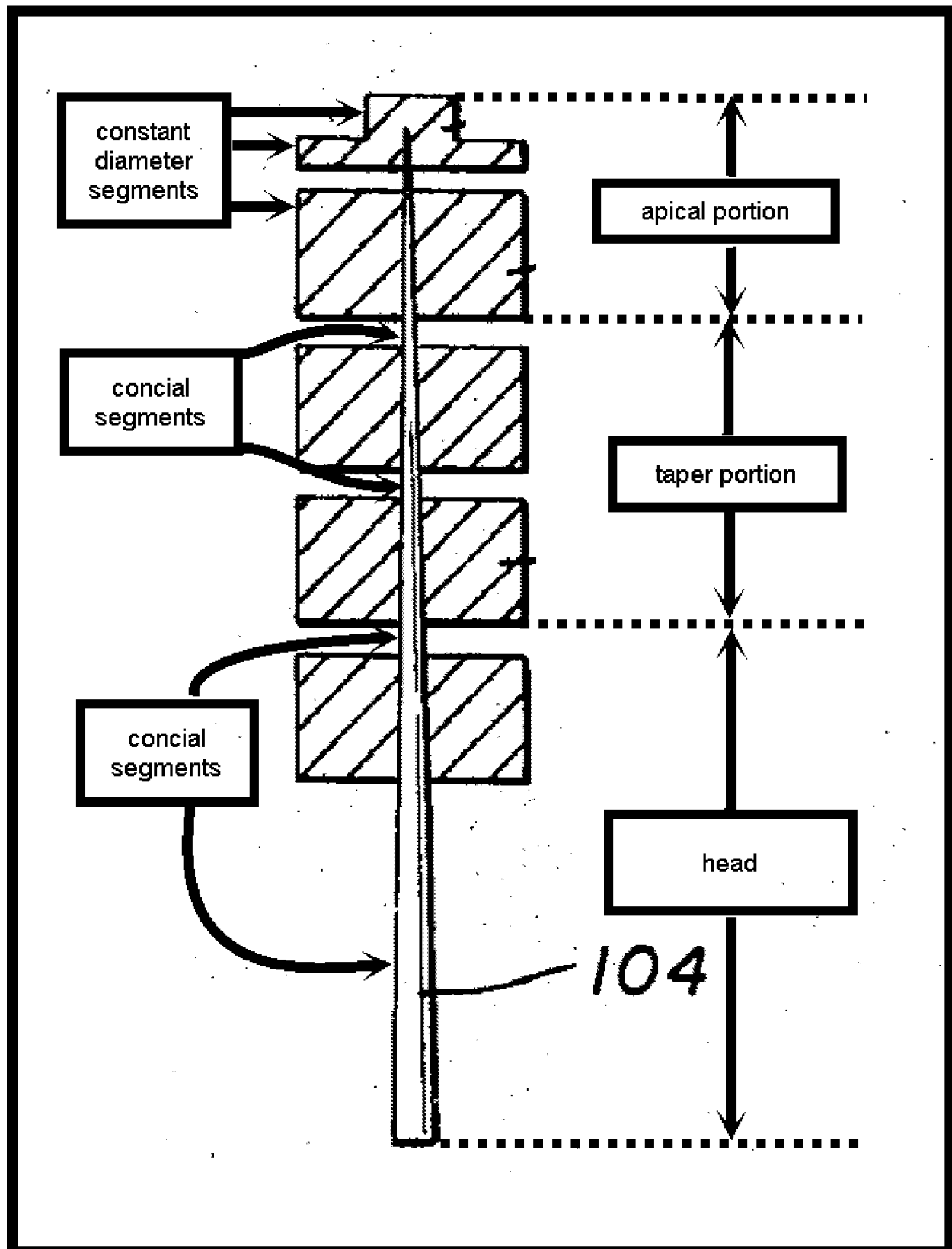
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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Malmin (U.S. 3,949,479).

15. Per claim 11, figure 14 of Malmin teaches an intra-radicular post of adjustable dimensions, for rebuilding of teeth, with treatment passages, including an apical portion (as illustrated below), formed by constant diameter segments (as illustrated below, the Examiner notes, the segments shown below are of constant diameter because each segment has a constant diameter), a tapered body (as illustrated below), formed by conical segments (i.e., the tapered portions of the metal core pin, 104 as illustrated below) and adjacent the apical portion; and a head (as illustrated below), formed by conical segments (as illustrated below), and adjacent to the tapered body.

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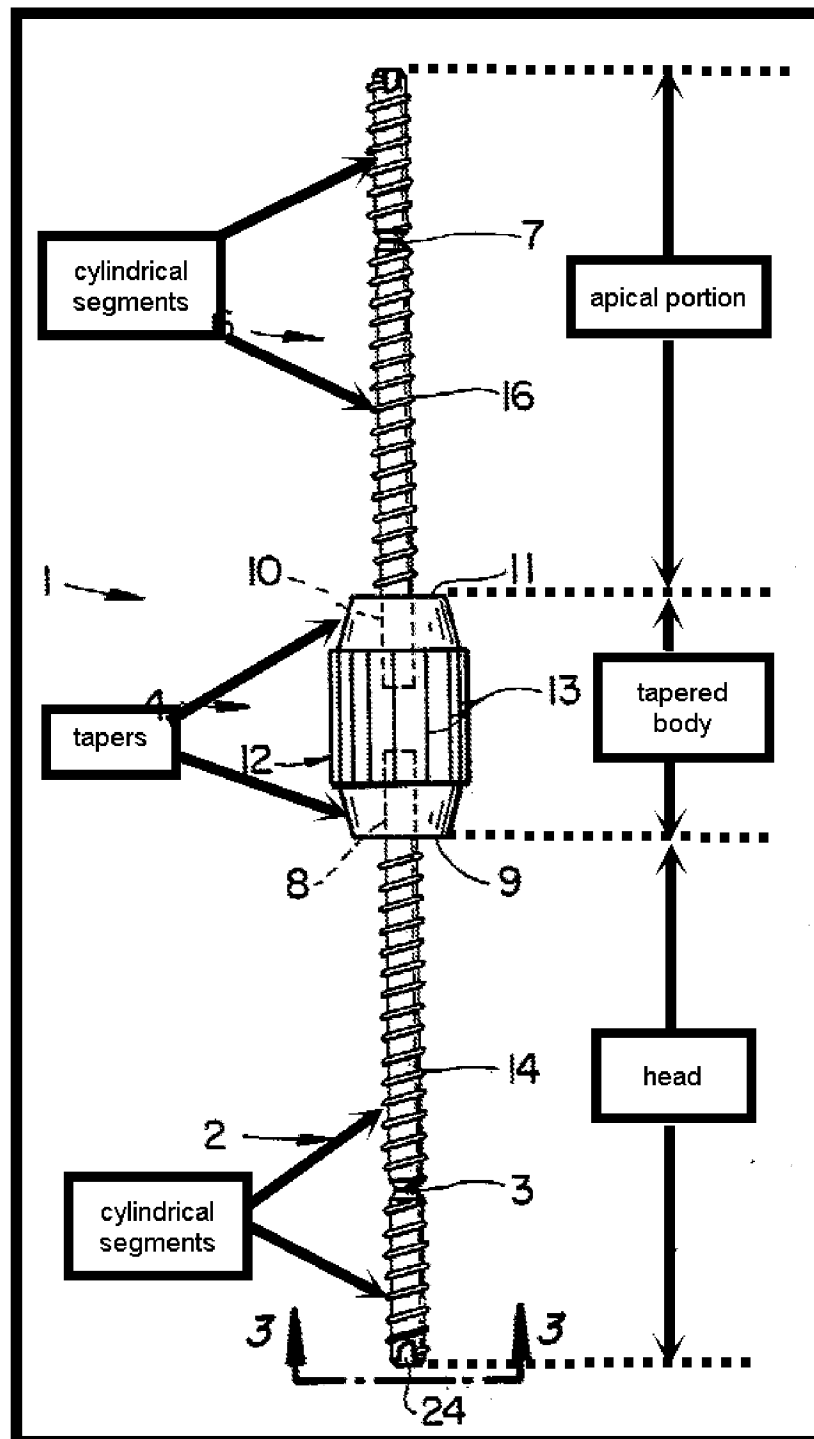


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16. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rovins (U.S. 4,171,569).

17. Per claims 18-20 figure 1 of Rovins teaches an intra-radicular post of adjustable dimensions, for rebuilding of teeth, with treatment of the passages, including an apical portion (6) formed by a plurality of cylindrical segments (i.e., shaft 6, where the segments are delineated by the fracture groove, 7), a taper body (i.e., the handle 4 has a tapered portion at each end, as illustrated below) adjacent to the apical portion (6), a head (i.e., shaft, 2) adjacent the body, formed by a plurality of cylindrical segments (i.e., shaft 2, where the segments are delineated by the fracture groove, 3); where upon the post height can be modified by realizing a cut in the apical portion (at the fracture groove, 7) and a cut in the post head (at the fracture groove, 3). The Examiner notes that "whereupon the post height can be modified by realizing at least one of up to two cuts in the apical portion and up to three cuts in the post head" is a functional limitation. A functional limitation use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the device of Rovins is capable of being cut at least at the fracture grooves (3 and 7) and could additionally be cut anywhere along the length of the device multiple times. As such, the Examiner submits, the device of Rovins anticipates claims 18-20 as claimed.

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Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 11- 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garman (U.S. 5,857,852) in view of Malmin (U.S. 3,949,479).

20. Per claim 11, Garman teaches an intra-radicular post of adjustable dimensions, for rebuilding teeth, with treatment of passages, the post including an apical portion (as illustrated below), a tapered body portion (as illustrated below), formed by conical segments and adjacent to the apical portion (as illustrated below), a head formed by conical segments and adjacent to the tapered portion (as illustrated below).

21. The Examiner notes, Garman fails to explicitly teach the apical portion formed by constant diameter segments as claimed. However, figure 11-14 of Malmin teach an apical portion of a post (i.e., reamer 540, figure 11) having constant diameter segments (it is clear from figure 14 that the apical most part comprises two segments having different constant diameters). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Garman to include the apical portion with constant diameter segments as taught by Malmin in order to distribute the forces within the canal laterally, thereby sealing the canals rather than exerting full pressure in the apical foramen (Malmin, column 1, lines 58-62).

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22. Per claim 12 and 13, Garman teaches the tapered body has a taper of 0.04 inches per inch (which is equivalent to 0.04 mm/mm which is within the claimed range of 0.03 and 0.07 mm/mm per claim 12, and is equal to the .04 mm/mm of claim 13).

23. Per claim 14, the Examiner notes, neither Garman nor Malmin explicitly teach the tapered portion has a taper of 0.06 mm/mm. However, the instant disclosure describes this parameter as being merely preferable (see page 7, lines 15-17), and does not describe it as contributing any unexpected results to the post. As such this parameter is deemed a matter of design choice (lacking in any criticality), well within the skill of the ordinary artisan, obtained through routine experimentation in determining the optimum results.

24. Per claim 15, figure 3 of Garman teaches the head comprises two lateral flat faces (i.e., legs, 69).

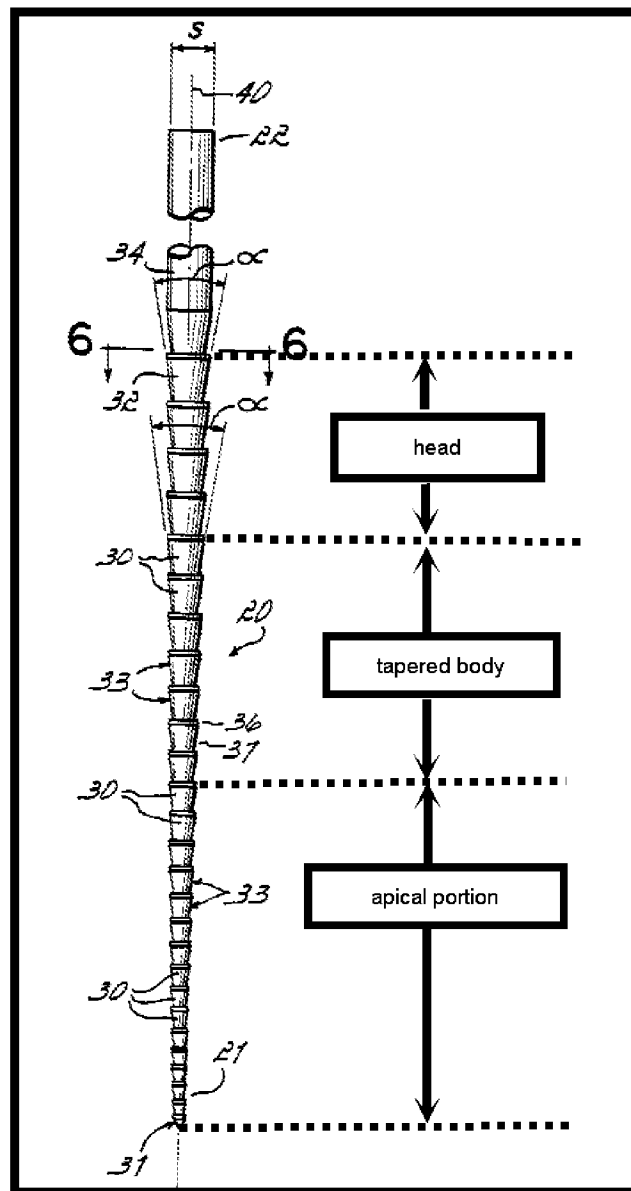
25. Per claim 16, the Examiner notes neither Garman nor Malmin teach each segment of the post has a height of approximately 1 mm. However, the instant disclosure describes this parameter as being merely preferable (see page 4, lines 28-30), and does not describe it as contributing any unexpected results to the post. As such this parameter is deemed a matter of design choice (lacking in any criticality), well within the skill of the ordinary artisan, obtained through routine experimentation in determining the optimum results.

26. Per claim 17, the Examiner notes, the claim limitations "said tapered body comprises seven conical segments" has been interpreted to be met by an tapered body portion including seven or more segments, since the term comprises is "open-ended" and does not exclude additional structure. Similarly the claim as interpreted by the Examiner requires three or more cylindrical segments in the apical portion and four or more conical head segments. As illustrated

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below, Garman teaches a tapered body having at least seven conical segments, and a head having at least four conical segments. The modification of Garman in view of Malmin with respect to claim 11 above would provided a apical portion with at least three cylindrical segments as figure 14 of Malmin clearly shows 5 cylindrical segments. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Garman having seven conical segments in the tapered body and four conical segments in the head) to include the three cylindrical segments of Malmin (i.e., figure 14 of Malmin shows five cylindrical segments), in order to distribute the forces within the canal laterally, thereby sealing the canals rather than exerting full pressure in the apical foramen (Malmin, column 1, lines 58-62).

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Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See PTO-892 form.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Ballinger whose telephone number is (571)270-5567.

The examiner can normally be reached on Monday thru Friday 8:00 AM to 5:00 PM.

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29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris L. Rodriguez can be reached on (571)272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael R Ballinger/
Examiner, Art Unit 3732

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732